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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,902	02/26/2004	Christopher W. Blackburn	1842.022US1	4532

70648 7590 07/09/2010

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EXAMINER	
RENWICK, REGINALD A	

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
07/09/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspto@slwip.com
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Office Action Summary	Application No.	Applicant(s)	
	10/788,902	BLACKBURN ET AL.	
	Examiner	Art Unit	
	REGINALD A. RENWICK	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In view of the **Appeal Brief filed on 06/02/2009, PROSECUTION IS HEREBY REOPENED**. A new non-final rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-31 are rejected under 35 USC 101 as being directed to non-statutory subject matter because these are method or process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). *See* Diamond v. Diehr,

450 U.S. 175, 184 (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also In re Bilski (Fed Cir, 2007-1130, 10/30/2008) where the Fed. Cir. held that method claims must pass the "machine-or-transformation test" in order to be eligible for patent protection under 35 USC 101. The claim language of claim 1, 8, 13, does not incorporate enough structure into the body of the claim to actually transform a machine. Examiner suggests for the first limitation and associated limitations "using a processor to send service information." Furthermore, claims 20 and 27 need to state that the computer-readable medium is non-transitory. Such claims should be stated as "A non-transitory computer-readable medium…"

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 2, 5-10, 13, 14,17-20, 21, 24-27, 28, 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto (U.S. Patent No 6921331) in view of Giobbi (U.S. Patent No. 6,749,510)

Re claims 1, 8, 13, 20, and 27: Gatto discloses a method for providing a game update service (column 12: lines 12-19: updating game machines) in a gaming network the method comprising:

sending service information for the game update service from the game update service (column 12: lines 12-19: updating game machines) to a discovery agent (according to Applicant's specifications the discovery agent comprises many items, wherein in Gatto the discovery agent comprises local update database 704, local controller 706, computer network 202, a server 206, and central update database 702) on the gaming network, wherein the game update service provides game content for a plurality of gaming machines on the gaming network, wherein in response to a wager at a gaming machine of the plurality of gaming machines the gaming machine depicts indicia representative of a randomly selected outcome of a wagering game (column 4, lines 16-29: provides games);

in response to determining that the game update service is authentic and authorized (column 10, lines 58-60), publishing the service information to a service repository to make the game update service available on the gaming network (column 12, lines 29-33: "If there is any update, the local controller 706 downloads the update software and/or video sequence and/or graphics files from the central server 206 over the communications network 202 and stores the downloaded update in the local update database 704.");

receiving by the discovery agent a request for the location of the game update service from the gaming machine (column 12, lines 55-67: game machine subscribes

for updates within the local database, wherein to subscribe means to be notified of a new update and the location where it can be downloaded);

returning the service information for the game update service to the gaming machine (column 12, line 67 & column13, lines 1-4: it is obvious to one skilled in the art that a game machine can receive confirmation of the subscription as it falls within the purview of the present invention for updating a game machine);

using the service information for the game update service to register the gaming machine with the game update service (column 12, lines 60-65: the game machines are registered on a table for future uploading);

verifying that the gaming machine is authorized to utilize the game update service and processing one or more service requests between the gaming machine and the game update service to provide game content on the gaming machine (column 12, lines 60-65: all game machines that are subscribers to the service are registered and recorded on a table which the game system uses to provide updates to, wherein the game machine verifies that the correct game machine in the correct area, is receiving the update.)

Gatto fails to disclose “determining by the discovery agent if the game update service is authentic and authorized.” However, Giobbi teaches the need for authenticating and authorizing downloaded game data, for the purpose of compiling with local regulations. Therefore because Gatto discloses remotely sending game data from one location to another, it would have been obvious to authorize the data provided by the game update service, to comply with the local regulations within the state for which

the data is sent. Therefore it would have also have been obvious to download the data after the data has been deemed authentic.

Re claims 2, 9, 14, 21, and 28: Gatto discloses that the game update service comprises a web service (column 8, lines 45-46: Internet).

Re claim 5,17, and 24: Gatto discloses with respect to the method of claim 1, wherein the service request comprises a request to download game content to the gaming machine (column 12, lines 43-54: downloading game content).

Re claim 6, 18, and 25: Gatto discloses wherein the service request is initiated by the gaming machine (column 12, lines 55-60: The service request can be initiated by the game machine wherein it subscribes to a particular database to download data).

Re claim 7, 19, and 26: Gatto discloses wherein the service request is initiated by the game update service (column 12, lines 60-67: after the subscription has taken place, therein after the game update service can initiate the service request by identifying game machines and sending the game machines data).

Re claim 10, and 29: Gatto discloses wherein the service description comprises a web service description language (column 8, lines 40-42: it is inherent that the service

description comprises a web service description language in order to send information over the network).

6. Claims 3, 4, 11, 12, 15, 16, 22, 23, 30, 31 rejected under 35 U.S.C. 103(a) as being unpatentable over Gatto in view of Giobbi in further view of Mountain et. al. (U.S. PGPUB 2004/0128622).

Re claim 3, 11, 15, 22, and 30: Gatto as modified by Giobbi fails teach wherein the service request comprises a request for notification of a game content update by the gaming machine. However, similar to Gatto, Mountain discloses a publisher/subscriber method of updating computer devices over the Internet, wherein Mountain teaches transmitting a notification message to a subscribing device to inform the device that an update is available (0024). Furthermore, Mountain discloses that the notification is sent after a subscription event has occurred (Fig. 4, object 430). Similarly, Gatto also discloses that gaming terminals subscribe to a specific event. Therefore it would have been obvious to modify the service request of Gatto to further comprise of a notification as taught by Mountain, for the purpose informing the game machine when a predetermined event has occurred. Furthermore, by combining a notification request with Gatto, the request to subscribe to a game update is also a request for a notification, since you can not receive the notification without a subscription.

Re claim 4, 16, and 23: Gatto as modified by Giobbi fails to disclose with respect to the method of claim 1: receiving a game content change; and issuing a notification of the game content update to the gaming machine in response to the game content change. However, Mountain discloses receiving a game content change (0018: pub-server receives an update data and after receiving a update notification from the publisher); and issuing a notification of the game content update to the gaming machine in response to the game content change (0020: issues a notification to machines about the update on the pub-server). Because Gatto discloses that a plurality of updating methods are applicable to the invention (column 12, line 67 & column 13, lines 1-4), it would have been obvious to try to modify Gatto with the notification and request to download content method of Mountain, for the purpose of informing game machines when there is an update available for download.

Re claim 12 and 31: Gatto as modified by Giobbi fails to disclose with respect to the method of claim 11, receiving a notification that game content has been updated; and issuing a request to download the game content. However, Mountain discloses receiving a notification that game content has been updated (0019); and issuing a request to download the game content (0020: the subscriber (e.g., Subscriber S.sub.1 132) may request 280 for the data cached at the web services pub-sub server 110). Because Gatto discloses that a plurality of updating methods are applicable to the invention (column 12, line 67 & column 13, lines 1-4), it would have been obvious to try to modify Gatto with the notification and request to download content method of

Mountain, for the purpose of informing game machines when there is an update available for download.

Response to Arguments

5. Applicant's arguments, see pages 17 and 18, filed 06/02/2009, with respect to claim 1 have been fully considered and are persuasive. The final rejection of 08/06/2008 has been withdrawn. The examiner has provided a new rejection under different art that meets the claim limitations. The art of Wesley U.S. Patent No. 7,039,701 is no longer used in this rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD A. RENWICK whose telephone number is (571)270-1913. The examiner can normally be reached on Monday-Friday, 7:30AM-5:00PM, Alt Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. R./
Examiner, Art Unit 3714

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714